

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Zhong Dong et al
Assignee: ProMOS Tech. Inc.
Title: METHOD OF FORMING ONO-TYPE SIDEWALL WITH
REDUCED BIRD'S BEAK
Serial No.: 10/821,100 Filing Date: April 7, 2004
Examiner: Vu David Group Art Unit: 2818
Docket No.: M-15295 US Confirmation No.: 8965

San Jose, California
September 13, 2007

VIA EFS-WEB
c/o Mail Stop AF
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

**BRIEF IN SUPPORT OF APPLICANT'S REQUEST FOR
PRE-APPEAL BRIEF CONFERENCE**

Dear Sir:

Pursuant to Notices given by the PTO of availability of a Pre-Appeal Brief Conference Pilot Program (see OG Notices: 07 February 2006), Applicant hereby petitions for inclusion of the above case, including its administrative record to date, for reconsideration by a fair and impartial panel of competent examiners and technical staff.

Qualification for Participation: Applicant submits that rejections made in the present case are based upon clear errors in fact finding and on omissions of essential elements required to support a prima facie case of rejection. In other words, there are clear legal and factual deficiencies in the outstanding grounds of rejections rather than gray zone issues of interpretation of the claims or of prior art teachings.

Content of Request: A separate paper entitled, "Pre-Appeal Brief Request for Review" accompanies this succinct, concise and focused set of arguments for which the review is being requested. A formal Notice of Appeal to the Board of Appeals is filed herewith.

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Specific Issues: This request specifies the following errors (1)-(4) in the examiner's rejections and in the examiner's omissions of one or more essential elements needed for presentation of a *prima facie* case of rejection to the Board of Appeals.

(Issue 1) By law the Examiner is required to reconsider the totality of the record including all evidence and argumentation of record and to provide Applicant with due notification including "reasons" pursuant to 35 USC §132(a). Applicant filed a Response to Final on 8/14/07 pointing to testimony of record that contradicts the Examiner's factual findings as well as providing new argumentation. On 8/24/07, an Advisory Action issued stating merely that the Examiner is not persuaded because the Examiner is not persuaded. This is not a reason but rather a raw conclusion. 35 USC §132(a) says "Whenever, on examination, ...". That means that the "reasons" required by §132(a) must be provided "whenever" the application is reconsidered. Otherwise, without reasons, the issued Office action creates the appearance of being an arbitrary and capricious one and it is not in accordance with law (with 35 USC §132(a) which requires "reasons").

(Issue 2) Claim 1 recites: "at least three exposed material layers" [*Emphasis added.*] So does Claim 23. To date the Examiner has presented no showing of how this limitation is met. Thus a prima facie case has never been made. By contrast, Applicant has presented rebuttal evidence (testimony) showing that the ordinary artisan would be guided by the primary reference You '613 to not have exposed layers. Thus evidence of an away teaching has been submitted by Applicant and has not been adequately addressed by the PTO:

(Issue 3) Claim 1 recites: "a dry ISSG process" with specific parameters. So does Claim 23. Applicant has presented rebuttal evidence (testimony) showing that the primary reference, You '613 would have guided the ordinary artisan away from use of ISSG and towards use of only a "dry oxidation" which has no hydrogen. To date the Examiner has not responded to this rebuttal evidence. The "evidence" is the Rule 132 Declaration which is distinct from the argumentation of counsel provided elsewhere. The Rule 132 Declaration also counters the Examiners assertion about ISSG always providing excellent results no matter what the specifics are of the ISSG and the work piece subjected to it.

(**Issue 4**) Applicant has presented argumentation as to why the primary reference, You '613 provides a complete solution to Bird's Beak and why common sense therefore dictates against finding an alternate solution. Nothing has been shown to be "broken" (deficient) in You's approach of first nitriding the ONO sidewalls so as to have no layer exposed. Common sense of the skilled artisan also dictates against using anything other than the tried and proven "dry" oxidation of You '613 given that a nitride outer coating is present in the structure of You to retard disparity among oxidation rates. To date the Examiner has not responded to this rebuttal argument.

Detailed Discussion

This is an opportunity for the review panel to demonstrate that they adhere to traditional notions of fair play and due process of law and can give Applicant an actual hearing rather than a pro forma dismissal.

MPEP 706.07 explains: "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." [*Emphasis added.*]

It is well established that anticipation is the epitome of obviousness. In the obviousness-based case of In re Kumar, 76 USPQ2d 1048 (Fed. Cir. August 15, 2005), the court confirmed the well established law that "[d]uring examination, the examiner bears the initial burden of establishing a prima facie case of obviousness. *Oetiker*, 977 F.2d at 1445. The prima facie case is a procedural tool, and requires that the examiner initially produce **evidence sufficient to support** a ruling of obviousness; thereafter the burden shifts to the applicant to come forward with evidence or argument in rebuttal. *Piasecki*, 745 F.2d at 1475. **When rebuttal evidence is provided, the prima facie case dissolves**, and the decision is made on the entirety of the evidence. *Oetiker*, 977 F.2d at 1445; *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976)." The Kumar court further held that the PTO "committed procedural error in refusing to consider the evidence proffered in response. See *In re DeBlauwe*, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984) ("Where the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence")." The Kumar court additionally held that "In accordance with the Administrative Procedure Act, the agency [PTO] must assure that an

applicant's petition is fully and fairly treated at the administrative level, without interim need for judicial intervention. See *Dickinson v. Zurko*, 527 U.S. 150, 154 (1999) (the PTO is an agency subject to the Administrative Procedure Act)." [*Emphasis added.*]

In the present case, Applicant submitted rebuttal "evidence" (a Rule 132 Declaration) showing that grounds of rejection are premised on errors of fact: more specifically that You '613 teaches to **not** have any exposed layers and that You '613 **teaches away from** ISSG. See the Response of November 2006, and more specifically the Rule 132 Declaration at page 10, beginning at the end of paragraph 4i re the exposed layers issue ("where a nitride barrier covers the exterior ... and impedes the advancement of the oxidation agent") as well as paragraphs 4j-4L. See the Rule 132 Declaration at pages 5-7, paragraphs 4d-4e re the "dry" oxidation issue. See pages 11-13 paragraph 4L for a summary of the Declarant's expert conclusions.

In the Office Action of 1/26/2007 the PTO dismisses the Rule 132 Declaration at page at page 6, paragraph 6 thereof as "merely stating opinion" and thus apparently not being worthy of careful consideration.

The PTO refers to the expert testimony within the Rule 132 as "Applicant argues ...". This is procedurally incorrect (see MPEP §716.01(d)) and a violation of Applicant's due process rights. The Rule 132 Declaration is sworn-to testimony provided by an expert witness.

All expert testimony is "opinion". There is no other kind. See 37 CFR §41.158 (Expert testimony). See MPEP §716.01(c) (Probative Value of Objective Evidence). In Applicant's case, an objective opinion has been provided by a credentialed expert as to how the ordinary artisan thinks and this has been backed up by clearly articulated reasons.

In contrast, the PTO has provided no evidence showing insight into how the ordinary artisan thinks. The rejection is a made up story having no basis in actual facts. The "structure of You" does not have exposed layers. Despite this, the PTO persists in talking about the "structure of You" and how an ordinary artisan would be motivated to apply a specific dry ISSG to a fictionally revised structure. See the Final Action of 7/13/07 page 4, paragraph 2 where it refers to You col. 7, lines 58-67. This "post-anneal" structure of You col. 7, lines 58-67 appears only "Subsequently" (col. 6, line 60), after the first nitride layer (col. 6, line 28) has been formed where the first nitride layer operates "so that oxidizing agents do not penetrate into the central portion of the ONO layer 108" (col. 6, lines 34-36, *emphasis added.*) That is why the second nitride layer is referred to by You as a "supplemental" nitride layer.

Applicant has presented rebuttal evidence and rebuttal arguments repeatedly in the record. The last presentation was on 8/14/07 and it pointed to specific passages in the Rule 132 Declaration that contradict the Examiner's findings of fact. At this stage of the proceedings, the initial case presented by the Examiner has legally "dissolved" because Applicant had presented rebuttal evidence and argumentation. Before the case is ripe for presentation to the Board of Appeals it is incumbent upon the Examiner to address the "entirety" of the evidence and arguments in the administrative record. Instead, on 8/24/2007 in the Advisory Action, the Examiner summarily dismisses the response without addressing the entirety of the evidence and arguments on the record and without giving Applicant any form of fair notice concerning the current basis of rejection based on the record as a whole.

Given that a Notice of Appeal is filed herewith, prosecution will close at the end of this pre-Appeal Review process. The Board of Appeals will in all likelihood want to be apprised of the Examiner's position regarding the totality of evidence and argumentation made of record. Thus this case is not ripe for appeal and the finality should be withdrawn until the Examiner completes the record by giving reasons.

CONCLUSION

In view of the above, it is again respectfully requested that rejections based on the erroneous reading of You '613 be withdrawn and, absent some new legitimate basis for rejection, that all claims of record be allowed.

<p align="center">CERTIFICATE OF EFS-WEB TRANSMISSION</p> <p>Certificate of Transmission: I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office (USPTO) via the USPTO's EFS-Web electronic filing system on <u>9-14-07</u> (Date).</p> <p>Typed or printed name of person signing this certificate: <u>Gideon Gimlan</u></p> <p>Signature: <u>[Signature]</u></p>
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Respectfully submitted,

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